

REMARKS

In this paper, claims 1, 11, 37, 38, 61, 63-65 and 67 are currently amended, claims 62 and 66 have been canceled, and claims 69-71 have been added. After entry of the above amendment, claims 1-61, 63-65 and 67-71 are pending, and claims 62 and 66 have been canceled.

Claims 1 and 11 have been amended in this paper to include the features of claims 62 and 66, respectively, which were considered allowable. As noted previously, support for this language may be found at col. 11, lines 12-29 and Fig. 5 which describe how the input cam (90) and the output cam (91) move axially relative to each other without such movement being caused by one of the input cam member (90) or the output cam member (91) screwing through the other one of the input cam member (90) or the output cam member (91).

Claim 37 has been amended in this paper to clarify that "the cable support extends from a surface of the caliper housing and is not adjustable relative to the surface of the caliper housing," Support for this feature may be found at col. 7, lines 33-37 and Figs. 2, 4, 7 and 8 which describe and show how support member (44) extends outwardly from body portion (42).

For claim 38, Fig. 44 shows that the second portion of the guide surface is formed by a projection that forms a circumferentially elongated protuberance (98i) that points in a rotational direction of the actuating arm towards the cable support (44) as shown in Fig. 2.

Claims 61 and 65, deemed allowable in the office action if rewritten to be in independent form, have been amended to be in independent form including all of the features of claims 1 and 11 from which they respectively depend.

Claims 63 and 67 have been amended to be in independent form including all of the features of claims 1 and 11 from which they respectively depend.

For claims 64 and 68, it is clear from Fig. 5 that a force between the first camming surface (90d) and the second camming surface (19c) that causes the output cam (91) to move axially from

the operation of the first camming surface (90d) and the second camming surface (19c) is disposed radially outwardly from the bore (91e, Fig. 34) in output cam (91).

For new claim 69, as shown particularly in Fig. 7, the left caliper housing (38) and cable support member (44) are one piece.

For new claim 70, Fig. 7 shows cable support member (44) comprising an elongated member.

For new claim 71, col. 7, lines 38-40 and Fig. 8 discuss and show how the elongated support member (44) forms the opening (72) such that the opening for guiding the cable is immovable relative to the surface of the caliper housing (38).

Claims 37-53 were rejected under 35 U.S.C. §251 as being improperly broadened by attempting to recapture previously surrendered subject matter. This basis for rejection is respectfully traversed.

As noted previously, *Clement* is a typical recapture case wherein a limiting feature was added to an existing element, and then that limiting feature was deleted in the reissue proceeding. More specifically, original claim 1 in the Clement patent was directed to a method for treating waste paper that removes "stickies," such as glues and plastics, under a first set of environmental conditions, before removing inks under a second set of environmental conditions. The original claim recited, *inter alia*, (a) forming an aqueous pulp of said material at low temperature and low specific mechanical energy; (b) separating non-ink contaminants by mechanical separation; (c) softening ink particles by submitting the pulp to high temperature, high shear forces, and at least one de-inking agent under alkaline conditions; and (d) detaching the ink particles by submitting the pulp to high temperature, high shear forces, and at least one chemical dispersing agent under alkaline conditions. During prosecution, these steps were amended, *inter alia*, by limiting step (a) to room temperature and a mechanical energy of lower than 50 KW.H/Ton; by limiting step (b) to room temperature; and by limiting steps (c) and (d) to a temperature between 85° and 130° C, mechanical energy more than 50 KW.H/Ton, and strong alkaline conditions having a pH of at least 9. In the reissue application,

the narrowing features were canceled while retaining the corresponding steps. The Court held that the deletion of the added features constituted an impermissible recapture of previously surrendered subject matter.

In *Meyers*, the claims were directed to features of a night vision system. Each original claim included a pulsing circuit for a light-emitting diode (LED). During prosecution, the patentee distinguished over the prior art by amended the pulsing circuit to add two limitations: (1) that the circuit would pulse on and off at intervals that resulted in the LED being off more often than on; and (2) that the pulsing circuit, when on, would pulse at a substantially higher level of power than it would be able to sustain if left on continuously. The pulsing circuit, including the two added features, was deleted from the claims. The Court held that deletion of the pulsing circuit, together with the two features added to the pulsing circuit to distinguish over the prior art, did not constitute impermissible recapture.

These two cases can be understood by the following analogy: If a claim recites $A + B + C$ and is amended during prosecution to recite $A + B + C + C'$, wherein C' is a feature of element C , then C' cannot be deleted in a reissue proceeding. That is the *Clement* case. However, if a claim recites $A + B + C$ and is amended during prosecution to recite $A + B + C + C'$, wherein C' is a feature of element C , then the claim may be amended in a reissue proceeding to delete C and C' and recite $A + B + D$, wherein feature D is a narrowing feature independent of element C . That is the *Meyers* case. The patentee in the *Meyers* case was not attempting to recapture protection of $A + B + C$, but was attempting to protect an independent invention $A + B + D$.

The present application is similar to *Meyers* in that the original claims recited “first and second cam members”, i.e., element “C.” During prosecution of the original patent, the first and second cam members were amended to include their respective input and output designations as well as the movement and camming surface features. The added features collectively can be called feature C' . If the preliminary amendment merely deleted the input and output designations as well as

the movement and camming surface features and otherwise kept the two cam members, then the examiner would be correct that *Clement* prevents such an amendment.

However, there is a difference between deleting a limiting *feature* that was added to an element versus deleting the element itself. *Clement* applies to the former, whereas *Meyers* applies to the latter. In other words, the preliminary amendment in this case canceled not just feature C', but element C (the two cams) as well. The actuating arm (equivalent to "element D") was added to protect an invention that is independent of an invention that involves the cams.

Claims 1-3, 6, 7, 11-15, 21-25, 32, 36, 63, 64, 67 and 68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carre, et al, et al (US 4,582,177) in view of Huang (US 6,148,964). Independent claims 1 and 11 have been amended to include the features of claims 62 and 66, respectively, which were considered allowable, so it is believed that this basis for rejection has been overcome.

As for claims 63 and 67, the office action refers to the teachings of Le Deit, et al, but the statement of rejection did not include Le Deit, and no motivation was stated for applying the teachings of Le Deit, et al either to Carre, et al or to Huang. In fact, Carre, et al relies on direct contact between the screw threads in order to operate. It would be impossible to have Carre, et al's screw threads spaced apart and still function. Nor is there any motivation to add a second camming function to the Carre, et al device.

Claims 37-45 and 47-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Le Deit, et al (US 5,647,475) in view of Carre, et al and Huang. This basis for rejection is respectfully traversed.

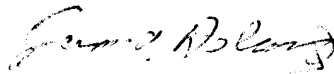
Claim 37 has been amended to clarify that the cable support extends from a surface of the caliper housing and is not adjustable relative to the surface of the caliper housing. The very purpose of the Le Deit, et al caliper is to allow the bracing piece (44) to be adjusted relative to the housing (10) to compensate for manufacturing variations in the position of the actuating lever (32). Making bracing piece (44) nonadjustable would destroy the objective of Le Deit, et al. It is not obvious to

modify a prior art device in a manner that destroys its intended operation. In re Gordon, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In addition to the above, neither Le Deit, Carre, et al nor Huang disclose or suggest a circumferentially *elongated* protuberance that points in a rotational direction of the actuating arm towards the cable support where the cable passes through the cable support as recited in amended claim 38; a cable support that is one piece with the surface of the caliper housing from which it extends as recited in claim 69; or an elongated member that forms an opening such that the opening for guiding the cable is immovable relative to the surface of the caliper housing as recited in claim 71.

Accordingly, it is believed that the rejections under 35 U.S.C. §103 and §251 have been overcome by the foregoing amendment and remarks, and it is submitted that the claims are in condition for allowance. Reconsideration of this application as amended is respectfully requested. Allowance of all claims is earnestly solicited.

Respectfully submitted,



James A. Deland
Reg. No. 31,242

DELAND LAW OFFICE
P.O. Box 69
Klamath River, California 96050
(530) 465-2430